

Terry S. Davidson
Application No. 10/713,643
Reply to Office Action mailed July 5, 2005

Attorney Docket: A-14-4

REMARKS

Re. The Office Action

As set forth in the Office Action, Claims 1-24 are pending. By the present reply, Claim 21 is deleted. Thus, Claims 1-20 and 22-24 are pending. Further, by the Office Action,

(i) Claim 20 is rejected under 35 U.S.C. 112, first paragraph, for failing to comply with the enablement requirement in that the disclosure is silent with respect to forming the cap of electrically conductive material that forms part of the return electrode because it is unclear how such structure is formed.

(ii) Claims 1-24 are rejected under 35 U.S.C. 112 second paragraph as being indefinite, because:

- (a) in Claim 1, (e) "the single active electrode" is not set forth;
- (b) Claim 16 fails to set forth sufficient steps to define how the instrument is employed to effect the result; and
- (c) in Claim 21, (d) "the single active electrode" is not set forth.

(iii) Claims 1-8 and 13-23 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent no. 5,944,717 ("Goble '717").

(iv) Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goble '717 in view of the skill in the art.

(v) Claim 24 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Goble '717 in view of U.S. patent no. 6,293,942 ("Goble '942").

(vi) Claims 1-14 and 21-23 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-15 of U.S. patent no. 6,296,638. In this regard the Office Action advised that a timely filed disclaimer in compliance with 37 CFR 1.3219(c) may be used to overcome this ground for rejection, provided that it is shown that the conflicting patent is commonly owned.

For the reasons set forth herein, reconsideration and allowance of the Application is respectfully requested.

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The rejection of Claim 20, under 35 U.S.C. 112, first paragraph

Claim 20 is amended to clarify that the cap is electrically conductive and comprises a portion of the return electrode. Accordingly, withdrawal of this basis for rejecting the claim is respectfully requested.

The rejection of Claims 1-24 under 35 U.S.C. 112, second paragraph

Claim 1, and thus its dependent Claims 2-20 and 22-24, is amended to clarify that the distal opening of the aspiration lumen is coupled to the active screen electrode. Also, Claim 16 is amended to set forth steps that define a method that employs the claimed instrument to effect the results achieved. Accordingly, withdrawal of this basis for rejecting the claims is respectfully requested.

Rejection of Claim 1-8 and 13-23 under 35 U.S.C. 102 (e) as being anticipated by U.S. patent no. 5,944,717 ("Goble '717"), in particular the Fig. 5 embodiment

Regarding this basis for rejecting the claims, Claim 1 is amended to specify that the Applicant's active electrode is comprised of a substantially flat screen electrode disposed on the distal end portion of the shaft, as indicated for example, in Figs. 27, 28, 30 and 31 of the specification.

As amended, Claim 1 and its dependent claims thus are patentably distinct over Goble '717 under 35 U.S.C. 102 (e), since Goble '717 does not disclose a flat screen electrode, but rather discloses a curved screen electrode that bulges and therefore is not flat, and which extends laterally through the cut-out provided in the insulation at the distal end of the shaft, as indicated in Fig. 5, and as disclosed for example at Col.4, lines 4-7.

Further, with regard to this rejection, Goble '717 does not: (i) teach an electrical coupling member comprised of a ballwire as set forth in Claim 9, as indicated in the Applicant's Fig. 27, with reference to no. 934 in the specification, at page 51; or (ii) teach circular or triangular apertures as set forth in Claims 12 and 14; or (iii) teach an aspiration lumen and an liquid supply lumen as set forth in Claims 1 and 23.

Thus, withdrawal of this basis for rejecting the claims is respectfully requested.

Rejection of Claims 10 and 12 under 35 U.S.C. 103(a) as being unpatentable over Goble '717 in that it would have been obvious in view of the skill in the art to (i) use plural couplings to ensure

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electrical connections between the conductor and the electrodes, and (ii) use the shapes of apertures as claimed

Regarding this basis for rejecting Claims 10 and 12, firstly as noted above, Goble '717 does not teach or suggest a flat screen active electrode as set forth in the claims.

Further, Goble '717 does not teach or suggest a ballwire type of coupling; in fact it is believed that one skilled in the art will eschew use of a ballwire coupling to secure Goble's active electrode because of Goble's curved surface (14). Additionally, Goble '717 does not teach or suggest an aspiration lumen set forth in the claims.

Thus, for at least these reasons, the cited references does not render Claims 10 and 12 unpatentable under 35 USC 103(a). Accordingly, withdrawal of this basis for rejecting the claims is respectfully requested.

Rejection of Claims 24 under 35 U.S.C. 103(a) as being unpatentable over Goble '717 in view of Goble '942

Regarding the rejection of Claim 24 as being unpatentable over Goble '717 in view of Goble '942, as discussed above neither of these references, either singly or together, teach or suggest using the Applicant's claimed instrument comprising a flat screen electrode to treat tissue by the method set forth in Claim 24.

Further, neither of the Goble references shows an aspiration lumen within the shaft wherein the screen electrode inhibits clogging, as set forth in the method of Claim 24.

Thus, for at least these reasons, the cited references does not render Claims 10 and 12 unpatentable under 35 U.S.C.103(a). Accordingly, withdrawal of this basis for rejecting the claims is respectfully requested.

Rejection of Claims 1-14 and 21-23 under the judicially created doctrine of obviousness type double patenting as being unpatentable over Claims 1-15 of U.S. patent no. 6,296,638

If it remains necessary, the Applicant will file a timely terminal disclaimer upon a determination that the claims are otherwise allowable. Accordingly, the Applicant respectfully request that this grounds for rejection be held in abeyance until the claims are allowed.

SUMMARY

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All claims are believed patentable over the cited references, and are in condition for allowance. Accordingly, reconsideration and allowance of the Application is respectfully requested. If an issue remains that can be resolved by telephone, kindly contact the undersigned at (408) 735-6486.

Respectfully submitted,

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